

## **REMARKS**

The Office Action mailed June 20, 2006 has been received and carefully considered. Claims 2-5 and 8-28 were examined on their merits. No claims have been cancelled, and no new claims have been added. Therefore, claims 2-5 and 8-28 are the claims currently pending in the present application. It is believed that this Amendment, in conjunction with the following remarks, places the application in immediate condition for allowance.

### **I. Overview Of Amendments**

Claims 2, 4, 8, 10-18 and 20-28 have been amended to more accurately describe the subject matter sought to be protected, to correct stylistic errors, and to correct errors noted by the Examiner. With respect to the errors noted by the Examiner, claim 18 has been amended to only refer to a first and other computers, correcting the lack of antecedent basis noted by the Examiner for the limitation "the first computer, second computer and control site computer." See Office Action page 2. As is more fully discussed below, this amendment is fully supported by specification and does not introduce any new matter. In addition, claim 20 has been amended to recite "the image relating to a region on the first computer's display," correcting the lack of antecedent basis noted by the Examiner for the limitation "the received image." See *id.* This amendment is supported by the specification and does not introduce new matter. See, e.g., present application pages 17-18, paragraph 46; pages 20-21, paragraph 53. Accordingly, any objections to claims 18 or 20 are respectfully requested to be withdrawn.

### **II. Obviousness-Type Double Patenting Rejections**

Claims 2-5 and 8-28 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being obvious over claims 1-16 of U.S. Patent No. 6,668,273 ("273"). Applicants respectfully request that this rejection be held in abeyance until all other substantive issues in this case have been resolved. At that time, Applicants will file the required terminal disclaimer. However, the filing of a terminal disclaimer in this case will not constitute an admission of the propriety of the obviousness-type double patenting rejection. See MPEP § 804.02; *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

### **III. The Enablement Rejection Of Claims 5, 16-20 And 25-28**

Claims 5, 16-20 and 25-28 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as

to enable one skilled in the art to make or use the invention. This rejection is hereby respectfully traversed for at least the reasons stated below.

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988); MPEP § 2164.01.

**A. Claim 5**

Original claim 5 recites the following limitation: “wherein the first and control site computers are the same computer.” The Examiner appears to argue that the specification only discloses a first and control site computer that are separate, and thus the specification fails to enable one skilled in the art to make or use invention as claimed in claim 5. *See* Office Action page 2. Applicants respectfully disagree. As disclosed in the present application, the invention, as claimed, can be practiced by a single machine that renders the logic elements of the invention in a form that instructs a computer to perform a sequence of function steps corresponding to those shown in the figures. *See, e.g.*, present application at page 10, paragraph 29. Thus, the specification does disclose the first and control site computers being the same computer, as recited in claim 5. Furthermore, one skilled in the art could easily combine the functions of the first and control site computers into a single computer as claimed. Indeed, in one embodiment of the invention, the only necessary steps would be to install a modern web browser on the control site computer to execute the presentation applet, and to connect the presentation applet to localhost to permit communication with the control module on the control site computer. *See, e.g.*, present application pages 11-12, paragraph 32. Such additional steps certainly cannot be considered undue experimentation. Also, one skilled in the art would be capable of combining the functions of the presentation applet and the control module into a single application or applet to perform all the functions of both the first and control site computers. Again, such experimentation is not undue. Moreover, those skilled in the art understand that a single computer typically executes multiple applications and services that are coupled using one of several data communication means, and further that multiple applications may equivalently be in one computer or in multiple computers provided that adequate data communication means interconnects the applications.

Finally, the Examiner has failed to establish a reasonable basis to question the enablement provided in the specification of the present application. *See In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); MPEP 2164.04. Again, the Examiner's sole assertion is that the specification only discloses a first and control site computer that are separate. *See Office Action* page 2. Even assuming, *arguendo*, that this assertion is correct, claim 5 is an original claim which sufficiently provides its own disclosure. *See MPEP* §2163.03. Accordingly, the Examiner is required to establish *why* the disclosure of claim 5 does not enable one skilled in the art to practice claim 5. The Examiner has failed to provide such information. As such, rejecting claim 5 for lack of enablement is improper.

In sum, because the specification does disclose the first and control site computers being the same computer, because combining the functionality of first and control site computers does not require undue experimentation, and because the Examiner has failed to establish a reasonable basis to question the enablement provided in the specification, the rejection of claim 5 under 35 U.S.C. § 112, first paragraph is improper. The Examiner is thus respectfully requested to reconsider and withdraw the 35 U.S.C. § 112, first paragraph rejection of claim 5.

**B. Claims 16-20 And 25-28**

Independent claims 16 and 25 recite the following limitation “composing a URL for an image related to a region selected on the computer’s display for display on at least one other computer...” The Examiner appears to argue that the specification only discloses composing a URL on one computer while the selected display is of another computer display. *See Office Action* page 2. Applicants respectfully disagree. As discussed above, and fully incorporated herein, both the specification and original claim 5 disclose the first and control site computers being the same computer. It follows that the functionality of the first computer-selecting a region on the computer’s display-and the functionality of the control site computer-composing a URL for an image related to the selected region-is also disclosed existing on a single computer, as recited in claims 16 and 25. Furthermore, as discussed above, and fully incorporated herein, any experimentation required to combine the functionality of the first and control site computers cannot be considered undue.

Accordingly, because the specification does disclose composing a URL for an image related to a region selected on the computer’s display for display on at least one other computer, and because combining the functionality of first and control site computers does not require

undue experimentation, the rejection of independent claims 15 and 25 under 35 U.S.C. § 112, first paragraph is improper. The Examiner is thus respectfully requested to reconsider and withdraw the 35 U.S.C. § 112, first paragraph rejection of claims 15 and 25, and any claims that depend therefrom.

#### **IV. The Obviousness Rejection Of Claims 2-5 And 8-28**

Claims 2-5 and 8-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Salesky et al., U.S. Patent No. 6,343,313 ("Salesky"), further in view of Mayle et al, U.S. Patent No. 6,542,936 ("Mayle"). See Office Action page 4. Claims 2, 12, 16, 21 and 25 are independent claims. Applicant respectfully requests that the Examiner reconsider the rejection for at least the reasons stated below.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Mayle is directed towards a system to create an electronic postcard to be viewed on a computer. See, e.g., Mayle Abstract. A user is given an editable webpage which serves as a template to create an electronic postcard. See, e.g., id. at column 8, lines 11-48. The user can add desired messages, contact information, and can change the style of the postcard. See, e.g., id; id at column 6, lines 33-54. The user is also permitted to upload an image from their computer to the system. See, e.g., id. at column 8, line 60 – column 9, line 5. Once the system receives the uploaded image, a series of processing steps are performed, and the system generates a composite image to be displayed as a part of the postcard. See id. at column 11, line 26 – column 12, line 65. The composite image is a representation of the image sent by the user with text layered on top. See id. at column 12, lines 13-65. The resulting postcard is an HTML page formatted in the style specified by the user, and containing the generated image and static

images. *See, e.g., id.* at Fig. 17; column 6, lines 33-54. The postcard is identified by a Card Key, and is accessed by a URL which contains the Card Key.

Salesky discloses a communications system where screen shots of a presenting screen image are taken at periodic intervals. *See, e.g., Salesky* column 7, lines 35-37; Figs 4D-6B. Each screen shot is broken down into smaller blocks of information, which are then compared to corresponding blocks from the previous screen shot. *See, e.g., Salesky* column 7, lines 38-42. If it is determined that a block has been updated, the block is transmitted to the attendee clients. *See, e.g., Salesky* column 7, line 66 – column 8, line 10. The attendee clients screens are updated block-by-block, from left to right within a row of blocks, and from top to bottom for each row. *See, e.g., Salesky* column 9, lines 57-63.

**A. Mayle and Salesky Fail To Teach Or Suggest All Of The Claim Limitations**

Independent claims 2, 12, 16, 21 and 25 have been amended to more accurately describe the subject matter sought to be protected, and each recite a variation of the following limitations: “composing a URL for a received image relating to a selected region of a computer’s display” and “receiving a request from the other computer containing the URL.”

**1. “composing a URL for a received image relating to a selected region of a computer’s display”**

The Examiner admits that Salesky does not disclose teach or suggest composing a URL for a received image to be a part of a request in order to transmit the image in response to a request. *See Office Action* page 4. Therefore, the Examiner must rely on Mayle to compensate for the foregoing deficiencies of Salesky. Mayle, however, also fails to disclose teach or suggest the above identified limitation.

The Examiner appears to argue that the disclosure in Mayle of a URL including a Card Key which is used to access a postcard teaches or suggests the claimed composing a URL for a received image relating to a selected region of a computer’s display. *See Office Action* page 4. Applicants respectfully disagree. Mayle has absolutely no disclosure teaching or suggestion regarding composing a URL for a received image, as claimed. Mayle teaches a system that generates an entirely new image, which, in part, contains the content of the image sent by the user. *See id.* at column 11, line 55 – column 12, line 65. Mayle discusses a lengthy process in which the image received from a user is ultimately used to generate a new image that forms a part of the postcard. The image sent by a user is uncompressed and converted, scaled, cropped,

combined with a caption image, and finally compressed and converted into a new image. Id. At no time whatsoever does Mayle teach or suggest composing a URL for anything actually received from a user. Indeed, the entire purpose of the system in Mayle, to create a postcard, would be defeated if Mayle taught or suggested composing a URL for a received image. Such a teaching or suggestion would mean the messages and different stylistic elements which comprise a postcard could not be added to the image sent by a user; the system disclosed in Mayle would be essentially worthless. Thus, Mayle fails to teach or suggest the claimed composing a URL for a received image.

Furthermore, even if it is assumed that Mayle does teach or suggest composing a URL for a received image, Mayle fails to teach or suggest composing a URL for a received image relating to a selected region of a computer's display, as claimed. Mayle merely discloses a user browsing their computer for an image to upload to the system. *See, e.g.*, Mayle Fig. 10. Wholly absent from Mayle is any disclosure regarding what the image or region uploaded to the system actually is. Accordingly, Mayle fails to teach or suggest the claimed composing a URL for a received image relating to a selected region of a computer's display.

Because Mayle fails to teach or suggest composing a URL for a received image, and fails to teach or suggest the receiving an image relating to a selected region of a computer's display, Mayle fails to teach or suggest the claimed composing a URL for a received image relating to a selected region of a computer's display. Hence, Mayle fails to cure the deficiencies of Salesky with respect to the limitation composing a URL for a received image relating to a selected region of a computer's display.

## **2. "receiving a request from the other computer containing the URL"**

The Examiner admits that Salesky does not disclose teach or suggest composing a URL for a received image to be a part of a request in order to transmit the image in response to a request. *See* Office Action page 4. Because Salesky fails to disclose composing a URL for a received image, it follows that Salesky also fails to disclose receiving a request from an other computer containing the URL, as claimed. Indeed, the system of Salesky does not receive specific image requests by clients. Rather, Salesky operates by utilizing an advanced filter to determine what data blocks to send to each client. *See, e.g.*, Salesky column 19, lines 34 – 47. The filter routes data blocks to different queues, which correspond to different classes of clients. *See* Salesky column 20, line 38 – column 21, line 54. Data blocks are then transmitted to the

clients based on their requests, e.g. “speed up” or “slow down.” *See* Salesky column 21, lines 55–60. A discarder is used when necessary to drop data blocks from the queue prior to sending blocks to the client. *See, e.g.,* Salesky column 21, lines 55–64. As taught in Salesky, the clients do not request blocks or images, by a URL or otherwise; rather the clients specify the speed that their queue of blocks is to be delivered, more quickly or more slowly, based on client performance capabilities. The blocks are then automatically sent to the client. Because Salesky fails to teach or suggest the claimed receiving a request from the other computer containing the URL, the Examiner must rely on Mayle to compensate for the foregoing deficiencies of Salesky. Mayle, however, also fails to disclose teach or suggest the above identified limitation.

As discussed above, and fully incorporated herein, Mayle fails to teach or suggest composing a URL for a received image relating to a selected region of a computer’s display. It also follows that Mayle does not teach or suggest receiving a request from an other computer containing the URL, as claimed, as it is impossible to teach or suggest receiving a request containing the URL when the URL itself has not been taught or suggested. Again, Mayle only discloses receiving requests for a postcard, which is an HTML file, and receiving requests for generated images which have not been received. *See, e.g.,* Mayle at column 13, lines 24–27; column 11, line 55 – column 12, line 65.

Because Mayle and Salesky both fail to teach or suggest the claimed receiving a request from the other computer containing the URL, and because Mayle and Salesky fail to teach or suggest the claimed composing a URL for a received image relating to a selected region of a computer’s display, the combination of Salesky and Mayle cannot reasonably be said to render obvious the claimed subject matter. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection from independent claims 2, 12, 16, 21 and 25 and the claims that depend therefrom.

**B. There Is No Suggestion To Combine Salesky With Mayle**

The Examiner appears to argue that the suggestion to modify the system of Salesky with the teaching of Mayle is to “enable the user of the other computer to view a particular image among a plurality of images residing in the control computer.” Office Action pages 4–5. Applicants respectfully disagree. As a preliminary matter, Salesky and Mayle fail to teach all of the claim limitations of the present invention, as discussed above, and fully incorporated herein. Accordingly, a suggestion to combine Salesky and Mayle is impossible and absent. Without

merely a suggestion, one would not (and could not) have been motivated to combine the teachings of Salesky with that of Mayle.

Even if it is assumed, *arguendo*, that the combination of Salesky and Mayle teaches all of the claim limitations of the present invention, combining Salesky with Mayle for the reasons suggested by the Examiner would result in a communication session that is something other than the claimed collaborative web browsing session. Put another way, even if Salesky and Mayle teach all of the claim limitations of the present invention, if Salesky and Mayle are combined as suggested by the Examiner, the resulting combination would not teach “for display on the other computer during a collaborative web browsing session,” as claimed in the present invention.

Finally, there is no suggestion to combine Salesky with Mayle in a manner as suggested by the Examiner. Salesky is directed towards permitting a presenter to control the display of an other computer during a desktop conference. *See, e.g.*, Salesky Column 2, lines 29-43. There is absolutely no teaching or suggestion in Salesky or Mayle regarding the desirability of letting a participant of a conference decide what image to view during a conference. Indeed, letting participants decide what image to view during a conference would permit the attendants to view images that are no longer current, turning Salesky into something other than a conferencing system. Enabling a client to have such capability appears detrimental to the operation of Salesky rather than advantageous. While Salesky does disclose a system in which a client can review previously conducted conferences, the capability does not extend to viewing individual images from a current conference, and there is no suggestion of any desirability for that functionality. *See, e.g.*, Salesky column 3, lines 59 – column 4, line 2. Accordingly, the suggestion to combine Salesky with Mayle as asserted by the Examiner is unfounded and improper.

Because Salesky and Mayle fail to teach all of the claim limitations of the present invention, because the combination of Salesky and Mayle as suggested by the Examiner results in a session that is not a collaborative web browsing session, and because there is wholly absent from Salesky and Mayle any suggestion to combine the references, there can be found no suggestion to combine Salesky and Mayle. Accordingly, the combination of Salesky and Mayle cannot be said to be obvious, and the Examiner is respectfully requested to reconsider and withdraw the § 103(a) rejection from independent claims 2, 12, 16, 21 and 25 and the claims that depend therefrom.



**CONCLUSION**

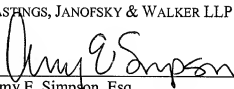
In view of the above, it is respectfully submitted that the present application is in condition for allowance. In the event that a variance exists between the amount tendered and that required by the U.S. Patent and Trademark Office to enter and consider this Amendment, or to prevent abandonment of the present application, please charge or credit such variance to the undersigned's Deposit Account No. 50-2613 Order No. (45098.00007.CON1.P1068) including the petition for extension of time.

Respectfully submitted,

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